

REMARKS

Applicants respectfully submit that no new matter has been added. Accordingly, Claims 42-47 and 54-83 are at issue.

The present invention is drawn to a system and apparatus for displaying advertising indicia on a wireless device. Referring to exemplary Claim 42, a page signal is received at a wireless device such as a pager, and in response thereto, an advertisement is immediately displayed at the pager. After waiting a predetermined period of time, paging information is then displayed at the pager. Later, the user can select to view the paging information. In response to that selection, the system detects a user preference, wherein the user preference indicates whether the user prefers to view the paging information without viewing the advertisement. In other words, the user has a choice between (a) viewing the paging information without viewing the advertisement, and (b) viewing the advertisement, and then viewing the paging information. The user's choice between those two alternatives is stored as a user preference. The present invention detects that preference and, based upon that preference, pursues the user-preferred alternative.

Another inventive aspect of the present invention relates to how the advertisements are programmed and stored at the wireless device. Referring to exemplary Claim 70, the wireless device has a set of advertisements and a set of periods of time. Each of the periods of time has a duration, which is the length of time for which the advertisement is displayed at the device. Furthermore, each of the periods of time is programmable so as to have a duration that is different from every other period of time. Each advertisement is associated with a subset of the periods of time. For example, and as described in the present application on page 10:

"if YAHOO and COKE placed advertising requests, and YAHOO paid more than COKE, then the wireless device 2 could be programmed to have a cycle with four slots, and YAHOO would take up three of the four slots, with COKE taking up the fourth slot. Thus, YAHOO would appear three times in a row, for the first three pages, and COKE would come up on the fourth page. This cycle can be repeated. Other numbers of slots in one cycle could also be used. Other programming methods come to mind by one of ordinary skill in the art, so long as the proper percentage of appearances is achieved."

As will be demonstrated herein, none of the prior art cited by the Examiner, either alone or in combination, discloses or suggests those aspects of the present invention.

Remarks Concerning Rejections Under 35 U.S.C. § 112

On page 2 of the March 3, 2006 Office Action, the Examiner rejected Claims 42-47 and 54-69 under § 112, as failing to comply with the written description requirement. Applicant respectfully argues that the claims do not contain subject matter which was failed to be described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Regarding claims 42-47 and 54-69, the limitation of the user preference indicates whether the user prefers to view the paging information without viewing the advertisement is described in the specification. Specifically, the specification recites that "the user can choose to view the source of the page again at a later time with or without the advertising indicia appearing before the source of the page is displayed." (page 11 lines 24-25). Applicants thus respectfully submit that claims 42-47 and 54-69 are patentable and that the rejection be withdrawn.

Remarks Concerning Rejections Under 35 U.S.C. § 103

U.S. Patent No. 6,031,467 to Hymel et al ("Hymel") in view of U.S. Patent No. 6,819,225 to Wicks et al. ("Wicks")

On page 3 of the March 3, 2006 final Office Action, the Examiner rejected Claims 42-43, 54-55, 60 and 64-65 under § 103(a) as being unpatentable over Hymel in view of Wicks. In light of the arguments made herein, Applicants respectfully traverse that rejection.

Hymel is directed to a radio that receives personal messages and corresponding advertisements. To view personal messages on the radio, the user is first required to view the advertisement. If the user views the personal message *without* viewing the advertisement, the user is penalized by having the radio disabled from receiving other personal messages (col. 4, ll. 41-54). As the Examiner acknowledged on page 4 of the March 3, 2006 Office Action, Hymel

fails to disclose detecting a user preference to view paging information without viewing an advertisement.

Wicks fails to cure the deficiencies of Hymel. Wicks is directed to a pager that receives pricing information. The pricing information is compared to a user profile that describes the interests of the pager user. If the pricing information matches the interests in the user profile, then the pricing information is transmitted to the pager. On page 4 of the March 3, 2006 Office Action, the Examiner equated that functionality with the user preference of the present invention. Those two features, however, are not analogous. In the present invention, the user preference describes whether the user wishes to view paging information *without* viewing advertising information. The "user profile" described in Wicks does not contain any preference to that effect; it relates only generally to the interests of the user, such as "an interest in sports" or "an interest in movies", *not* to whether the user prefers to view paging information without viewing advertising information. In other words, the user profile of Wicks determines which messages the user will receive, whereas the user preference of the present invention determines how those messages will be viewed. The two are not analogous.

Claims 42, 54, 60 and 64 have all been previously amended to clarify that the user preference of the present invention indicates whether the user prefers to view paging information without viewing an advertisement. Neither Hymel nor Wicks discloses or suggests that element. Applicants therefore respectfully submit that Claims 42, 54, 60 and 64 are patentable over Hymel and Wicks, and request that the rejection based on those references be withdrawn.

Dependent Claim 43 includes all of the features of Claim 42 and is therefore patentable over Hymel and Wicks for the same reasons. Likewise, dependent Claims 55 and 65 depend on Claims 54 and 64, respectively. Applicants therefore request that the § 103 rejection of the Claims 42-43, 54-55, 60 and 64-65 be withdrawn.

Hymel and Wicks in view of U.S. Patent No. 6,477,365 to Fukuda ("Fukuda")

On page 7 of the March 3, 2006 Office Action, the Examiner rejected Claims 45 and 67 as being unpatentable over Hymel and Wicks in further view of Fukuda. In light of the previous amendments, Applicants respectfully traverse that rejection.

Fukuda is directed a portable telephone communication system, wherein voice recordings are attached to communications between a mobile telephone and a radio tower. The Examiner has relied upon Fukuda for disclosing the feature of including a company name in an advertisement. Like Hymel and Wicks, however, Fukuda does not disclose a user preference that indicates whether a user prefers to view paging information without viewing an advertisement. Claims 42 and 60 both include that element, and therefore dependent Claims 45 and 67, respectively, include that element as well. Applicants thus respectfully submit that Claims 45 and 67 are patentable over that combination, and request that the rejection based thereon be withdrawn.

Hymel and Wicks in view of U.S. Patent No. 6,434,383 to Bruno et al. ("Bruno")

On page 8 of the March 3, 2006 Office Action, the Examiner rejected Claims 46-47 and 68-69 as being unpatentable over Hymel and Wicks in further view of Bruno. In light of the previous amendments, Applicants respectfully traverse that rejection.

Bruno is directed to a paging system that determines whether a user is logged into a computer network. If so, a page is directed to that user's personal computer. The Examiner has relied upon Bruno for disclosing the feature of paging information that includes a person's name and phone number. Like Hymel and Wicks, however, Bruno does not disclose a user preference that indicates whether a user prefers to view paging information without viewing an advertisement. Claims 42 and 60 both include that element, and therefore dependent Claims 46-47 and 68-69, respectively, include that element as well. Applicants thus respectfully submit that those claims are patentable over that combination, and request that the rejection based thereon be withdrawn.

U.S. Patent No. 6,674,357 to Bermel ("Bermel") in view of U.S. Patent No. 6,182,050 to Ballard ("Ballard")

On page 8 of the March 3, 2006 Office Action, the Examiner rejected claim 70 as being unpatentable over Bermel in view of Ballard. Claim 70 includes the element that a user preference indicating whether the user prefers to view paging information without viewing an advertisement. Bermel does not include this element. Bermel is directed to a system wherein

informational messages are associated with memory "slots" in a pager. However, Bermel does not disclose or suggest a user preference indicating whether the user prefers to view paging information without viewing an advertisement. On page 9 of the Office Action, the Examiner recognizes that Bermel is not explicit in teaching each of the advertisements is associated with a period of time and each of the duration of time is programmable to be different from another. Applicants respectfully suggests that the Examiner has not pointed to anything specific in Ballard which would be obvious to one of ordinary skill in the art to combine the two references. Thus, Applicants respectfully request the rejection be withdrawn.

Bermel in view of Ballard and U.S. Patent No. 6,157,814 to Hymel et al. ("Hymel II")

On page 9 of the March 3, 2006 Office Action, the Examiner rejected Claims 73, 71-72, and 77-80 as being unpatentable over Bermel in view of Ballard and further in view of Hymel II. Applicant respectfully suggests that the Examiner has not pointed to anything specific in the references which would make it obvious to one of ordinary skill in the art to combine the references. Thus, Applicants respectfully request the rejection be withdrawn.

Bermel in view of Ballard and Fukada

On page 12 of the March 3, 2006 Office Action, the Examiner rejected Claims 74 and 81 as unpatentable over Bermel in view of Ballard and further in view of Fukada. For the same reasons as set forth above, Applicant respectfully argues that the Examiner has not pointed to anything specific that would make it obvious to one of ordinary skill in the art to combine the references as suggested. Thus, Applicants respectfully request the rejection be withdrawn.

Bermel in view of Ballard and Bruno

On page 12 of the March 3, 2006 Office Action, the Examiner rejected Claims 75-76 as unpatentable over Bermel in view of Ballard and further in view of Bruno. For the same reasons as set forth above, Applicant respectfully argues that the Examiner has not pointed to anything specific that would make it obvious to one of ordinary skill in the art to combine the references as suggested. Thus, Applicants respectfully request the rejection be withdrawn.

Hymel in view of Wicks and Hymel II

On page 13 of the March 3, 2006 Office Action, the Examiner rejected Claims 44, 56-57 and 66 as being unpatentable over Hymel and Wicks in view of Hymel II. In light of the previous amendments, Applicants respectfully traverse that rejection.

Neither Hymel, Wicks nor Hymel II disclose a user preference indicating whether the user prefers to view paging information without viewing an advertisement. Claims 42, 54 and 60 all include that element. Dependent Claims 44, 56-57 and 66, respectively, therefore also include that element. Applicants thus respectfully submit that Claims 44, 56-57 and 66 are patentable over the combination of Hymel, Wicks and Hymel II, and request that the rejection based on those references be withdrawn.

Hymel in view of Wicks and Bruno

On page 15 of the March 3, 2006 Office Action, the Examiner rejected claims 58-59 as unpatentable over Hymel in view of Wicks and further in view of Bruno. Applicants respectfully argue that the Examiner has failed to point to any specific reference which would have made it obvious to one of ordinary skill in the art to combine the references as suggested. As such, Applicants respectfully request the rejection be withdrawn.

Hymel and Wicks in view of U.S. Patent No. 6,008,819 to Robson et al. ("Robson")

On page 16 of the March 3, 2006 Office Action, the Examiner rejected Claim 61 as being unpatentable over Hymel and Wicks in view of Robson. In light of the previous amendments, Applicants respectfully traverse that rejection.

Robson is directed to an information retrieval device that receives a portion of a document. Based upon input from the user, additional information is transmitted to the device, such as another portion of the document, or a nested hyperlink. Robson does not disclose, however, a user preference indicating whether the user prefers to view paging information without first viewing an advertisement. As noted previously, Hymel and Wicks also fail to disclose that element, which is found in Claim 60. Claim 61 is dependent upon Claim 60, and therefore also includes that element. Applicants therefore respectfully submit that Claim 61 is

patentable over the combination of Hymel, Wicks and Robson, and request that the rejection based on those references be withdrawn.

Hymel in view of Wicks and Bruno

On page 16 of the March 3, 2006 Office Action, the Examiner rejected claims 62-63 as unpatentable over Hymel in view of Wicks and further in view of Bruno. Applicants respectfully argue that the Examiner has failed to point to any specific reference which would have made it obvious to one of ordinary skill in the art to combine the references as suggested. As such, Applicants respectfully request the rejection be withdrawn.

Bermel in view of Hymel and Bruno

On page 17, the Examiner rejected Claims 82-83 over Bermel in view of Hymel and further in view of Bruno. Applicants respectfully argue that the Examiner has failed to point to any specific reference which would have made it obvious to one of ordinary skill in the art to combine the references as suggested. As such, Applicants respectfully request the rejection be withdrawn.

Hymel in view of U.S. Patent No. 6,674,357 to Bermel ("Bermel")

On page 8 of the March 3, 2006 Office Action, the Examiner rejected Claims 49, 50, 71-73 and 77-80 as being unpatentable over Hymel in view of Bermel. Claim 50 has been canceled, rendering moot that rejection. As to Claims 49, 71-73 and 77-80, in light of the amendments made herein, Applicants respectfully traverse that rejection.

As described previously, Bermel is directed to a system wherein informational messages are associated with memory "slots" in a pager. The Examiner has relied upon Bermel for disclosing the step of programming a pager at a service provider or retailer. However, as described previously, neither Hymel nor Bermel disclose or suggest a user preference indicating whether the user prefers to view paging information without viewing an advertisement. Claims 42 and 70 both include that element, and therefore dependent Claims 49 and 71-73, respectively, include that element as well. The combination of Hymel and Bermel thus does not render

Claims 49 and 71-73 unpatentable. Applicants respectfully submit that those claims are patentable over Hymel and Bermel, and request that the rejection based thereon be withdrawn.

Hymel and Bermel also fail to disclose another element found in Claims 77-80, which is the step of associating an advertisement with a subset of periods of time within the wireless device. In the present invention, each advertisement is associated with a subset of time periods, and it is that association which determines the frequency with which the advertisement will be displayed. Neither Hymel nor Bermel discloses that element. Applicants therefore respectfully submit that Claims 77-80 are patentable over the combination of Hymel and Bermel, and request that the rejection based on those references be withdrawn.

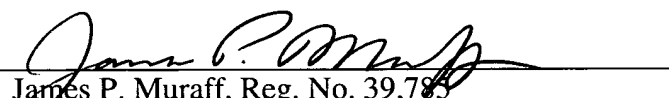
CONCLUSION

In light of the remarks made herein, Applicants respectfully submit that Claims 42-47 and 54-83 are in condition for allowance. Applicants respectfully request that the Examiner withdraw the rejections and allow all the claims to issue. If it may be of assistance to contact the undersigned Attorney regarding the present invention, the Examiner is invited to do so.

Respectfully submitted,

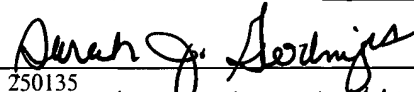
Dated: September 5, 2006

By:


James P. Muraff, Reg. No. 39,785
Wallenstein & Wagner, Ltd.
311 South Wacker Drive, 53rd Floor
Chicago, Illinois 60606-6630
312.554.3300

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SARAH J. Goodnight